



TO AIR \$

PTO/SB/17 (07-07)

Approved for use through 06/30/2010. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2007		Complete if Known	
		Application Number	09/678,328-Conf. #4817
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Filing Date	October 3, 2000
TOTAL AMOUNT OF PAYMENT (\$) 500.00		First Named Inventor	Yasuo TAKANE
		Examiner Name	Y. K. Aggarwal
		Art Unit	2622
		Attorney Docket No.	0905-0247P

METHOD OF PAYMENT (check all that apply)	
<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card
<input type="checkbox"/> Money Order	<input type="checkbox"/> None
<input type="checkbox"/> Other (please identify): _____	
<input checked="" type="checkbox"/> Deposit Account	Deposit Account Number: 02-2448
Deposit Account Name: Birch, Stewart, Kolasch & Birch,	
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)	
<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments

FEE CALCULATION							
1. BASIC FILING, SEARCH, AND EXAMINATION FEES							
	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
2. EXCESS CLAIM FEES							
Fee Description	Fee (\$)	Small Entity Fee (\$)					
Each claim over 20 (including Reissues)	50	25					
Each independent claim over 3 (including Reissues)	200	100					
Multiple dependent claims	360	180					
Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims			
- = x =				Fee (\$)	Fee Paid (\$)		
HP = highest number of total claims paid for, if greater than 20.							
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)				
- = x =							
HP = highest number of independent claims paid for, if greater than 3.							
3. APPLICATION SIZE FEE							
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)			
- 100 =		/50 =	(round up to a whole number) x				
4. OTHER FEE(S)							
Non-English Specification, \$130 fee (no small entity discount)				Fees Paid (\$)			
Other (e.g., late filing surcharge) 1402 Filing a brief in support of an appeal				500.00			

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	32,181
Name (Print/Type)	Marc S. Weiner	Telephone	(703) 205-8000
		Date	JUL 23 2007



TRANSMITTAL OF APPEAL BRIEF

Docket No.
0905-0247P

In re Application of: Yasuo TAKANE

Application No.	Filing Date	Examiner	Group Art Unit
09/678,328-Conf. #4817	October 3, 2000	Y. K. Aggarwal	2622

Invention: DIGITAL CAMERA AND METHOD OF CONTROLLING THE SAME AND APPARATUS FOR AND METHOD OF OUTPUTTING IMAGE

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: May 23, 2007.

The fee for filing this Appeal Brief is \$ 500.00.

☒ Large Entity ☐ Small Entity

☐ A petition for extension of time is also enclosed.

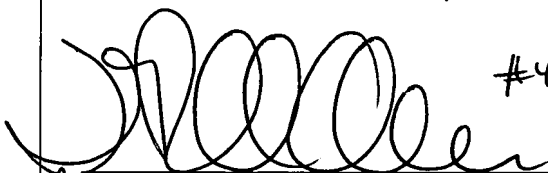
The fee for the extension of time is _____.

☐ A check in the amount of _____ is enclosed.

☒ Charge the amount of the fee to Deposit Account No. 02-2448.
This sheet is submitted in duplicate.

☐ Payment by credit card. Form PTO-2038 is attached.

☒ The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 02-2448.
This sheet is submitted in duplicate.

 #40,439

Dated: JUL 23 2007

Marc S. Weiner
Attorney Reg. No. : 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000

Appl. No. 09/678,328



MS APPEAL BRIEF
PATENT
0905-0247P

IN THE U.S. PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Yasuo TAKANE

APPEAL NO.:

APPL. NO.: 09/678,328

GROUP: 2622

FILED: October 3, 2000

EXAMINER: Y.K. AGGARWAL

FOR: DIGITAL CAMERA AND METHOD OF CONTROLLING THE SAME
AND APPARATUS FOR AND METHOD OF OUTPUTTING IMAGE

APPEAL BRIEF

07/24/2007 JADD01 00000119 022448 09678328
01 FC:1402 500.00 DA



TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST	2
II.	RELATED APPEALS AND INTERFERENCES.....	2
III.	STATUS OF THE CLAIMS	2
IV.	STATUS OF AMENDMENTS	2
V.	SUMMARY OF CLAIMED SUBJECT MATTER	2
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
VII.	ARGUMENTS.....	4
VIII.	CONCLUSION.....	13
IX.	CLAIMS APPENDIX.....	A1
X.	EVIDENCE APPENDIX.....	B1
XI.	RELATED PROCEEDINGS APPENDIX.....	B1



MS APPEAL BRIEF
PATENT
0905-0247P

IN THE U.S. PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BEFORE THE BOARD OF APPEALS

Yasuo TAKANE

APPEAL NO.:

APPL. NO.: 09/678,328

GROUP: 2622

FILED: October 3, 2000

EXAMINER: Y.K. AGGARWAL

FOR: DITIGAL CAMERA AND METHOD OF CONTROLLING THE SAME
AND APPARATUS FOR AND METHOD OF OUTPUTTING IMAGE

APPEAL BRIEF
ON BEHALF OF APPELLANT:
YASUO TAKANE

MS APPEAL BRIEF
Board of Patent Appeals
and Interferences
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby submits the following Appeal Brief in support of the Notice of Appeal filed
May 23, 2007.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the entire interest in the above-captioned patent application, FUJIFILM Corporation, 210 Nakanuma, Minami-Ashigara-shi, Kanagawa 250-0123, Japan.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 1-14 are pending in the above-captioned application. Claims 2-9 and 11-12 are withdrawn from consideration. Claims 1 and 10 are independent. Claims 1, 10 and 13-14 are presently rejected. The rejection of claims 1, 10 and 13-14 is being appealed.

IV. STATUS OF AMENDMENTS

No amendments were filed after the final rejection dated January 26, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention of claim 1 provides for a digital camera comprising a photometry device for performing photometry for each of the sections obtained by dividing an imaging area into a plurality of sections to output photometry values [Specification, page 11, lines 12-18]; an imaging device 5 for imaging a subject, to output image data representing an image of the subject [Specification, page 11, line 22 through page 12, line 2]; an exposure control device for controlling an amount of exposure in said imaging device on the basis of the photometry values outputted by said photometry device [Specification, page 12, line 24 through page 13, line 4]; an image file create device for creating an image file for each imaging by the imaging device, the image file create device recording in the image file the image data outputted from said imaging device and data representing the

photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections [Specification, page 13, line 14 through page 14, line 3]; and a recording control device for recording the image file created by said image file create device on a recording medium [Specification, page 13, lines 17-18].

The invention of claim 10 provides for a method of controlling a digital camera, comprising the steps of performing photometry for each of the sections obtained by dividing an imaging area into a plurality of sections to output photometry values [Specification, page 11, lines 12-18]; imaging a subject in an amount of exposure determined on the basis of the outputted photometry values [Specification, page 12, line 24 through page 13, line 4], to obtain image data representing an image of the subject [Specification, page 11, line 22 through page 12, line 2], wherein an image file is created with an image file create device, said image file including the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections, the image file create device creating the image file for each of imaging by said imaging device [Specification, page 13, line 14 through page 14, line 3]; and recording the image file created by said image file create device on a recording medium with a recording control device [Specification, page 13, lines 17-18].

The summary of the claimed invention herein has been made to comply with the Patent Office rules in submitting briefs and is not to be considered as limiting the claimed invention.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 10 and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sasaki et al.* (USP 5,559,860) (hereinafter, “*Sasaki*”) in view of *Takagi* (USP 5,319,416) (hereinafter, “*Takagi*”).

VII. ARGUMENTS

A. Argument Summary

The reasoning provided in support of the rejection of claims 1, 10 and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over *Sasaki* in view of *Takagi* fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that: (a) the rejection attributes certain claimed features to the primary and secondary references, *Sasaki* and *Takagi*, that a detailed reading of the reference reveals are not taught therein; (b) when the nature and purpose of the system disclosed by *Sasaki* is recognized, it is evident that there is no suggestion or motivation in *Takagi* or in knowledge generally available to those skilled in the art to modify *Sasaki* in a manner asserted by the rejection; and (c) by asserting that certain modifications to the system of *Sasaki* would have been obvious without a proper suggestion or motivation in the applied references or elsewhere to make the asserted modifications, the rejection appears to rely on impermissible hindsight reasoning. Such deficiencies exist for the rejection of each of claims 1, 10 and 13-14.

B. The Legal Requirements of *Prima Facie* Obviousness

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of the prior art must be supported by some teaching, suggestion, or motivation in the applied references or in knowledge generally available to one skilled in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Ehrreich, 590 F.2d 902, 908-909, 200 USPQ 504, 510 (C.C.P.A. 1979).

The teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In other words, the use of hindsight to reconstruct the claimed invention is impermissible. Uniroyal Inc. v. Rudlan-Wiley Corp., 5 USPQ 1434 (Fed. Cir. 1983).

Finally, when considering the differences between the primary reference and the claimed invention, the question for assessing obviousness is not whether the differences themselves would be obvious, but instead whether the claimed invention as a whole would have been obvious. Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

C. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 1

Independent claim 1 is directed to a digital camera comprising a photometry device for performing photometry for each of the sections obtained by dividing an imaging area into a plurality of sections to output photometry values; an imaging device for imaging a subject, to output image data representing an image of the subject; an exposure control device for controlling an amount of exposure in said imaging device on the basis of the photometry values outputted by said photometry device; an image file create device for creating an image file for each imaging by the imaging device, the image file create device recording in the image file the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections; and a recording control device for recording the image file created by said image file create device on a recording medium.

In maintaining his rejection of claim 1, the Examiner asserts in the final Official Action mailed January 26, 2007, starting on page 2, fifth paragraph, as follows:

Sasaki et al. teaches a digital camera (figure 6a and 6b) comprising a photometry device (19) for performing photometry to output photometry values (col. 4, lines 26-34, col. 6, lines 19-44);

An imaging device (26) for imaging a subject, to output image data representing an image of the subject (col. 4, lines 14-25).

An exposure control device for controlling an amount of exposure in said imaging device on the basis of the photometry values outputted by said photometry device (col. 4 lines 26-34 teach that upon half press of the shutter, the diaphragm 22 is controlled by the control circuit 24 according to the measured amount of the incident light by the exposure sensor 19 and col. 4 lines 38-57 teach when the shutter is fully pressed an image is captured. It would be obvious that the image is taken according to the value of the diaphragm set during the half press of the shutter) ;

An image create device for creating an image file for each of the imaging by said imaging device, containing the image data outputted from said imaging device and data representing the photometry values, the image file create device creating the image file; and

a recording control device for recording the image file created by said image file create device on a recording medium (figures 9e and 10, col. 8, lines 42-55, col. 9 lines 1-35 teach a file being created on a memory card 15 representing image data and exposure values). [The exposure value and the image data shown in block number 1H in figure 9E in the same recording device and portion is being read as an image file. A file is defined as a collection of data stored and dealt with as a single, named unit. Sasaki teaches block 11H showing exposure values stored within a single unit.

Sasaki teaches an exposure sensor 199 to measure the amount of incident light but fails to teach if this photometry device is used for performing photometry for each or the sections obtained by dividing an imaging area into a plurality of sections to output photometry values including the identification numbers that specify each of the sections.

However, Takagi teaches an image device (figure 2) having a divisional photometry section (figure 3) that performs photometry by divisional photometer element 11a to 11h arranged in correspondence with divisional photometric areas, F1 to F8, of a photographic frame. The divisional photometer elements 11a to 11h perform photometry on photometric areas F1 to F8 respectively. The reference numeral 12 converts photometric signals from the photometric elements 11a to 11h into photometry values $E(n)$ ($n=1$ to 8, in the units of BV) and stores these photometric values $E(1)$ to $E(8)$ in the AE output memory 20 (col. 3, lines 32-49).

Therefore, taking the combined teachings of Sasaki and Takagi, it would be obvious to one skilled in the art at the time of the invention to have been motivated to have used a photometry device for performing photometry for each of the sections obtained by dividing an imaging area into a plurality of sections to output photometry values including the identification numbers that specify each of the sections in order to provide an exposure calculation device for cameras that is capable of calculating a correct exposure for a principled object in a back-lighted or front lighted condition as taught in Takagi (col. 1, lines 41-45).

Appellant respectfully disagrees that the cited references, either alone or in combination, teach or suggest an image file create device for creating an image file for each imaging by the imaging device, the image file create device recording in the image file the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections, as recited in claim 1. Appellant further respectfully disagrees that these references are properly combinable.

1. The cited references fail to teach or suggest the image create device as recited in claim 1

The disclosure of *Takagi* is directed to an exposure calculation device for a camera. An exposure calculation device for cameras is equipped with: a divisional photometry device having a plurality of photometer elements for performing photometry respectively on each of a plurality of

divisional areas constituting a field; a photoelectric transfer element array for performing photometry on at least a part of the field; an edge detection device, which determines a boundary section defining on the photoelectric transfer element array a higher-photometry-output region and a lower-photometry-output region and which outputs edge information on this boundary section; a selection device, which selects at least one of the photometer elements of the divisional photometry device on the basis of the edge information, exposure calculation being enabled by the photometry output of the photometer element thus selected; and an exposure calculation device, which calculates a correct exposure for a principal object in the field on the basis of the photometry output of the selected photometer element. (Abstract)

Based on the teachings of *Takagi*, the only output of the exposure calculation device for the camera is the calculation of the correct exposure. There is no teaching or suggestion in *Takagi* that is directed to storing data representing the photometry values for each of the sections outputted from said photometry device.

The Examiner argues in his Advisory Action mailed May 16, 2007, that *Takagi* does teach storing the values in AE output memory 20. However, this response fails to address Appellant's argument. As can be clearly seen from col. 10, lines 38-56, *Takagi* discloses as follows:

The exposure value determined in this way is supplied to the exposure control section 90 in step S10 of FIG. 4. The exposure control section 90 controls the shutter mechanism section and the stop-down mechanism section (None of which is shown) on the basis of this exposure value to effect exposure.

When the principal object is thus judged to be in a sharply backlighted condition, an edge of the principal object is detected from the output wave shape of the photoelectric transfer element array 43a for focus detection to perform wave-shape sorting, and the photometry output of the photometric areas on that side of the edge where the photometry value is at a lower level is selected by an equation corresponding to the wave-shape pattern. That is, the photometry value of the photometric areas occupied by the principal object is used preferentially, thereby calculating a correct exposure value for the principal object.

Although the photometry values are stored in the AE output memory, there is no teaching or suggestion that these values are stored once a correct exposure value is calculated. As such, Appellant maintains that the only value that is output from the exposure calculation unit is a correct exposure value. As the photometry values are not output from the exposure calculation unit, Appellant maintains that *Takagi* fails to teach or suggest recording in the image file the image data

outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections.

Further, the Examiner asserts that *Sasaki* teaches “an image file create device for creating an image file for each of imaging by said imaging device, containing the image data output from said imaging device and data representing the photometry values, the image file create device creating the image file; and a recording control device for recording the image file created by said image file create device on a recording medium (e.g. figures 9e and 10, col. 8 lines 42-55, col. 9 lines 1-35 teach a file being created on a memory card 15 representing image data and exposure values).” (Official Action, page 3, lines 1-6).

Sasaki discloses at col. 8, lines 32-54 as follows:

In order to clarify the explanation, assume that approx. 40 Kbytes are necessary to store one frame data, for example. Then, the entry block number or 11H and the number of available blocks of 04H are written into the directory area, for example. 12H, 13H, 2AH and FFH are written into addresses 11H, 12H, 13H and 2AH. Image data of one frame is written into a 40-Kbyte area obtained by linking block numbers 11H, 12H, 13H and 2AH of the data area. FFH written into the address of 2AH of the FAT area indicates the last block. FIG. 9E shows the 40-Kbyte memory area obtained by linking the blocks. In the first block or 256-byte block of block number 11H, data indicating the presence or absence of the flash (or information as to whether the flash has been used or not), white balance data, and photographing condition data including the exposure value (or aperture value) and shutter speed are recorded, and the remaining 252-byte area is used as a user area for recording the title, for example. Image data may be successively recorded in an area from 257 th byte to block number 2AH. 64 blocks, 32 blocks, 16 blocks and 8 blocks are used respectively in modes (A), (B), (C) and (D).

However, in this citation, *Sasaki* merely discloses storing the exposure value (or aperture value). As *Takagi* merely discloses outputting an exposure value, the combination of the teachings of *Takagi* with the teachings of *Sasaki* would merely teach storing the correct exposure value, not each of the photometry values as claimed.

As such, the combination of the teachings of the cited references fail to teach or suggest “an image file create device for creating an image file for each imaging by the imaging device, the image file create device **recording in the image file the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said**

photometry device including the identification numbers for which specify each of the sections,”
as required by claim 1.

As neither of the cited references, either alone or in combination, teach or suggest recording in the image file the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers for which specify each of the sections, Appellant respectfully submits that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements. For at least this reason, Appellant respectfully submits that claim 1 is patentable over the references as cited.

2. The cited references in support of the rejection of claim 1 are not properly combinable as the suggested combination would require substantial reconstruction

It is well know that where the suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference, as well as a change in the basic principle under which the primary reference construction was designed to operate, then the combination would be improper. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner seeks to replace the exposure sensor of *Sasaki* with the photometry sensor and photometry circuit of *Takagi*. In order to do so, the camera of *Sasaki* would need to be substantially reconstructed to include all of the elements of microcomputer 23, and colorimetry circuit 14 (as the exposure is controlled using both data from the photometry circuit and the colorimetry circuit). As the inclusion of these components would require substantial reconstruction of the *Sasaki* camera, the Examiner’s combination of references is improper.

For at least this reason, Appellant respectfully submits that claim 1 is patentable over the references as cited by the Examiner.

3. The Examiner Relies on Improper Hindsight Reasoning in support of the rejection of claim 1

By asserting that it would have been obvious to modify *Sasaki* to include the purported features of *Takagi*, with no suggestion or motivation in the applied references or elsewhere to do so, the rejection appears to rely on impermissible hindsight reasoning.

For at least these reasons, Appellant submits that the rejection set forth in the Final Office Action fails to establish a *prima facie* case of obviousness of independent claim 1.

D. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 10

The invention of claim 10 is directed to a method of controlling a digital camera, comprising the steps of performing photometry for each of the sections obtained by dividing an imaging area into a plurality of sections to output photometry values; imaging a subject in an amount of exposure determined on the basis of the outputted photometry values, to obtain image data representing an image of the subject, wherein an image file is created with an image file create device, said image file including the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections, the image file create device creating the image file for each of imaging by said imaging device; and recording the image file created by said image file create device on a recording medium with a recording control device.

In support of the Examiner's rejection of claim 10, the Examiner relies on his discussion of the cited references with regard to claim 1. Appellant respectfully disagrees that the cited references teach or suggest an image file is created with an image file create device, said image file including the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections, the image file create device creating the image file for each of imaging by said imaging device, as required by claim 10. Appellant further respectfully submits that these references are not properly combinable.

1. **The cited references fail to teach or suggest the image create device as recited in claim 10**

As noted above with regard to claim 1, Appellant maintains that the combination of the teachings of the cited references fail to teach or suggest “an image file create device for creating an image file for each imaging by the imaging device, the image file create device **recording in the image file the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers for which specify each of the sections,**” as required by claim 1. As such, for the reasons noted above, Appellant further maintains the neither of the cited references, either alone or in combination, teach or suggest “wherein an image file is created with an image file create device, said image file including the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections,” as recited in claim 10.

As neither of the cited references, either alone or in combination, teach or suggest wherein an image file is created with an image file create device, said image file including the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections, Appellant respectfully submits that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements. For at least this reason, Appellant respectfully submits that claim 10 is patentable over the references as cited.

2. **The cited references in support of the rejection of claim 1 are not properly combinable as the suggested combination would require substantial reconstruction**

It is well know that where the suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference, as well as a change in the basic principle under which the primary reference construction was designed to

operate, then the combination would be improper. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner seeks to replace the exposure sensor of *Sasaki* with the photometry sensor and photometry circuit of *Takagi*. In order to do so, the camera of *Sasaki* would need to be substantially reconstructed to include all of the elements of microcomputer 23, and colorimetry circuit 14 (as the exposure is controlled using both data from the photometry circuit and the colorimetry circuit). As the inclusion of these components would require substantial reconstruction of the *Sasaki* camera, the Examiner's combination of references is improper.

For at least this reason, Appellant respectfully submits that claim 10 is patentable over the references as cited by the Examiner.

3. The Examiner Relies on Improper Hindsight Reasoning in support of the rejection of claim 10

By asserting that it would have been obvious to modify *Sasaki* to include the purported features of *Takagi*, with no suggestion or motivation in the applied references or elsewhere to do so, the rejection appears to rely on impermissible hindsight reasoning.

For at least these reasons, Appellant submits that the rejection set forth in the Final Office Action fails to establish a *prima facie* case of obviousness of independent claim 10.

E. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claims 13-14

Claims 13-14 depend either directly from claims 1 and 10, respectively. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Sasaki* in view of *Takagi* fails to establish *prima facie* obviousness of claims 13-14 for at least the reasons set forth above concerning claim 1 and 10, respectively. Appellant also submits that dependent claims 13-14 are separately patentable and offers the following additional argument for the invention of 13-14.

As discussed above with regard to claims 1 and 10, neither of the references, either alone or in combination, assuming these references are combinable, which Appellant does not admit, teach or

suggest recording in the image file the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers for which specify each of the sections,” as required by claim 1 and “wherein an image file is created with an image file create device, said image file including the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections,” as required by claim 10.

As the Examiner has failed to provide a reference that teaches or suggests each of the elements set forth in claims 13-14, in combination with the elements set forth in their respective independent claims 1 and 10, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a). Thus, claims 13-14 are patentable over *Sasaki* in view of *Takagi*.

VIII. CONCLUSION

The withdrawal of the outstanding rejections and the allowance of claims 1, 10 and 13-14 is earnestly solicited.

Dated: JUL 23 2007

Respectfully submitted,

#1 40,435

By

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Appellant

IX. CLAIMS APPENDIX

1. (Previously Presented) A digital camera comprising:

a photometry device for performing photometry for each of the sections obtained by dividing an imaging area into a plurality of sections to output photometry values;

an imaging device for imaging a subject, to output image data representing an image of the subject;

an exposure control device for controlling an amount of exposure in said imaging device on the basis of the photometry values outputted by said photometry device;

an image file create device for creating an image file for each imaging by the imaging device, the image file create device recording in the image file the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections; and

a recording control device for recording the image file created by said image file create device on a recording medium.

2. (Withdrawn) An image output apparatus comprising:

a reading device for reading, from a recording medium on which image data representing a subject image and data representing photometry values obtained by respectively performing photometry for a plurality of sections obtained by dividing an imaging area are recorded, the image data and the photometry value data being correlated to each other, the image data and the photometry value data;

a display control device for controlling a display device such that the subject image represented by the image data read by said reading device is displayed on a display screen; a designation device for designating a desired image zone in the subject image displayed on said display screen;

a brightness adjusting means for correcting, on the basis of the photometry value data corresponding to an image in the zone designated by said designation device, the brightness of the image in the designated zone; and an image data output device for outputting, the image data representing the image the brightness of which is corrected.

3. (Withdrawn) An image output apparatus comprising:
a reading device for reading, from a recording medium on which image data representing subject images of a plurality of frames which have been obtained by imaging a subject under different imaging conditions, the image data representing a specified frame of image;
a display control device for controlling a display device such that the subject image represented by the image data read by said reading device is displayed on a display screen;
a designation device for designating a desired image zone in the subject image displayed on said display screen;
retrieval means for retrieving a frame of image data representing the most proper subject image out of the subject images of the plurality of frames with regard to the image in the zone designated by said designation device; and an image data output device for outputting the image data found by said retrieval means.
4. (Withdrawn) The image output apparatus according to claim 3, wherein the imaging conditions is an exposure amount.
5. (Withdrawn) The image output apparatus according to claim 3, wherein the imaging conditions is a focal length.
6. (Withdrawn) The image output apparatus according to claim 4, wherein said retrieval means selects a frame of image data having the most proper brightness with regard to the image in the zone designated by said designation device.
7. (Withdrawn) The image output apparatus according to claim 6, further comprising an adjusting means for adjusting brightness of the image, in a zone corresponding -to the designated zone, of the selected frame of image data.
8. (Withdrawn) The image output apparatus according to claim 5, wherein said retrieval means selects a frame of image data having the most proper size with regard to the image in the zone designated by said designation device.

9. (Withdrawn) The image output apparatus according to claim 8, further comprising an enlarging means for enlarging the size of the image, in a zone corresponding to the designated zone, of the selected frame of image data.

10. (Previously Presented) A method of controlling a digital camera, comprising the steps of:

performing photometry for each of the sections obtained by dividing an imaging area into a plurality of sections to output photometry values;

imaging a subject in an amount of exposure determined on the basis of the outputted photometry values, to obtain image data representing an image of the subject, wherein an image file is created with an image file create device, said image file including the image data outputted from said imaging device and data representing the photometry values for each of the sections outputted from said photometry device including the identification numbers which specify each of the sections, the image file create device creating the image file for each of imaging by said imaging device; and

recording the image file created by said image file create device on a recording medium with a recording control device.

11. (Withdrawn) A method of outputting an image, comprising the steps of:

reading, from a recording medium on which image data representing a subject image and data representing photometry values obtained by respectively performing photometry for a plurality of sections obtained by dividing an imaging area are recorded with the image data and the photometry value data being related to each other, the image data and the photometry value data;

displaying on a display screen the subject image represented by the read image data;

designating a desired image zone in the subject image displayed on said display screen;

adjusting, on the basis of the photometry value data corresponding to an image in the designated

zone, the brightness of the image in the designated zone; and

outputting the image data representing the image the brightness of which is adjusted.

12. (Withdrawn) A method of outputting an image, comprising the steps of:
reading, from a recording medium on which image data representing subject images of a plurality of frames which have been obtained by imaging a subject under different imaging conditions, the image data representing a specified frame of image;
displaying on a display screen the subject image represented by the read image data;
designating a desired image zone in the subject image displayed on said display screen;
retrieving a frame of image data representing the most proper subject image out of the subject images of the plurality of frames with regard to the image in the designated zone; and
outputting the image data found by the retrieval.

13. (Previously presented) The digital camera of claim 1, wherein the output values of the photometry device are directly used to determine an amount of exposure.

14. (Previously presented) The digital camera of claim 10, wherein the output values of the photometry device are directly used to determine an amount of exposure.

X. Evidence Appendix

No evidence has been submitted under 37 C.F.R. 1.130, 1.131 or 1.132. No other evidence has been entered by the examiner and relied upon in this appeal.

XI. Related Proceedings Appendix

There are no related proceedings.